

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 4 and 16 (renumbered as 15 by the Examiner) are canceled, and claims 1, 13-15 and 17 are amended. Claims 1-3, 5-14 and 16 are pending in light of the aforementioned cancellations and amendments.

Reconsideration of the application is respectfully requested in view of the aforementioned amendment to the claims and the following remarks. For the convenience and reference of the Examiner, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. Claim Objections**

The Examiner has objected to the misnumbering of various claims. By this paper, Applicant has renumbered claims 13-17 as 12-16. In view of this amendment, Applicant respectfully submits that the objection has been overcome and should accordingly be withdrawn.

### **II. General Considerations**

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **III. Claim Rejections under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP § 2143*.

#### **a. claims 1-3 and 5-8**

The Examiner has rejected claims 1-3 and 5-8 as being obvious in view of various combinations of US 6,909,848 to Kim et al. ("*Kim*"), US 6,631,144 to Johansen et al. ("*Johansen*") and US Pub. 2002/0060824 to Liou et al. ("*Liou*"). Applicant respectfully disagrees, but submits that for at least the reasons set forth below, the rejection should be withdrawn.

By this paper, Applicant has amended claim 1 to include the limitations of claim 4, indicated by the Examiner to be in allowable condition. In view of the aforementioned amendment to claim 1, Applicant submits that claims 1-3 and 5-8 are now in allowable condition, and the rejection of claims 1-3 and 5-8 should accordingly be withdrawn.

#### **b. claims 9, 10 and 12-14 (formerly 13-15) and 16 (formerly 17)**

The Examiner has rejected claims 9, 10, 12-14 and 16 as being obvious over *Johansen* in view of US Pub. 2002/0060824 to Kato et al. ("*Kato*"). Applicant respectfully disagrees.

Among other things, claims 9 and 16 recite "... the transmit circuit being configured to set the operational data rate of the opto-electric device to successive data rates included in the plurality of automatically selectable data rates until one of the following occurs: the loss of lock signal asserted by the receive circuit ceases; or, each data rate in the plurality of automatically selectable data rates has been set ..." As to this limitation, the Examiner has asserted that *Johansen* discloses "... ((columns 17-18 lines 63-67 and 1-12 (lock detect circuit continuously monitors incoming line clock signal wherein only if there is a loss of lock brought on by a frequency larger than a predetermined value will a change in bit rate occur ...") *Emphasis added*.

In this regard however, Applicant notes that the portion of *Johansen* relied upon by the Examiner does not recite "... set[ting] the operational data rate of the opto-electric device to successive rates included in the plurality of automatically selectable data rates ..." or setting the operational data rates until one of the following occurs "... the loss of lock signal asserted by the receive circuit ceases; or, each data rate in the plurality of automatically selectable data rates has been set ..." (*emphasis added*) as

claims 9 and 16 require. Instead, the cited passage of *Johansen* appears to be concerned with clock signals.

Particularly, that passage states in part that “The lock detect circuit 425 continuously monitors a frequency difference between the reference clock signal on line 70 and the line clock signal from the VCXO. If these signals differ more than a predetermined value ... the scaling PLL is activated in the CDR circuit so that the CDR circuit is locked onto the line clock signal provided by the VCXO circuit rather than locked onto the incoming data stream. Hereby, it is assured that the CDR circuit is always kept within its lock-in range in relation to an expected bit rate of the incoming data stream if the incoming data stream for some reason is absent or at an erroneous bit rate.” *Col. 7, line 73 to col. 8, line 8. Emphasis added.*

Contrary to the assertion of the Examiner then, the passage of *Johansen* relied upon in the rejection of the claims appears to be concerned with clock signals and makes no apparent reference to “automatically selectable data rates” (*emphasis added*), or setting the operational data rates until one of the following occurs “... the loss of lock signal asserted by the receive circuit ceases; or, each data rate in the plurality of automatically selectable data rates has been set” (*emphasis added*) as recited in claims 9 and 16. Thus, even if the references are combined in the purportedly obvious fashion, the resulting combinations fail to include all the limitations of claims 9 and 16.

In light of the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 9 and 16, at least because the Examiner has not established that the references, when combined, teach or suggest all the limitations of the rejected claims.

By virtue of their dependence from claim 9, claims 10 and 12-14 include all the limitations of claim 9. As noted above however, the Examiner has failed to establish that *Johansen* and *Kato*, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claim 9. Moreover, the Examiner has not established that this defect is remedied by any other reference. Accordingly, the rejection of claims 10 and 12-14 should likewise be withdrawn.

**c. claim 11**

The Examiner has rejected claim 11 as being obvious over *Johansen* in view of US Pub. 2002/0060824 to Kato et al. (“*Kato*”) and further in view of *Liou*. Applicant respectfully disagrees.

By virtue of its dependence from claim 9, claim 11 includes all the limitations of claim 9. As noted above however, the Examiner has failed to establish that *Johansen* and *Kato*, when combined in the purportedly obvious fashion, teach or suggest all the limitations of claim 9. Moreover, the Examiner has

not established that this defect is remedied by *Liou*. Accordingly, Applicant respectfully submits that the rejection of claim 11 should be withdrawn.

**IV. Allowable Subject Matter**

The Examiner has indicated that claim 4 would be allowable if rewritten to include all the limitations of the base claim and those of any intervening claims. By this paper, Applicant has amended claim 1 to include the limitations of claim 4 and Applicant accordingly submits that claim 1, and corresponding dependent claims 2-3 and 5-8, are now in allowable condition.

In addition, the Examiner has indicated that claim 15 would be allowable if rewritten to include all the limitations of the base claim and those of any intervening claims. By this paper, Applicant has amended claim 14 to include the limitations of claim 15, and Applicant accordingly submits that claim 14 is now in allowable condition.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-3, 5-14 and 16 in this application is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 21<sup>ST</sup> day of July, 2006.

Respectfully submitted,



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